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Neil S. Eastman

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3 RECORD OF ORAL HEARING
4 UNITED STATES PATENT AND TRADEMARK OFFICE
5

6
7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES
9

10
11 Ex parte NEIL S. EASTMAN, MICHAEL ZINGMAN,
12 and MICHELLE SAMMARTINO
13

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15 Appeal 2010-010100
16 Application 10/626,244
17 Technology Center 2600
18

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20 Oral Hearing Held: October 12, 2010
21

22
23 Before JOHN C. MARTIN, THOMAS S. HAHN and
24 CARL W. WHITEHEAD, JR., Administrative Patent Judges
25

26
27 ON BEHALF OF THE APPELLANT:
28

29
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1 The above-entitled matter came on for hearing on Tuesday,
2 October 12, 2010, commencing at approximately 10:33 a.m., at the U.S.
3 Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia,
4 before Lorie B. Allen, Notary Public.

5 MR. HALEVA: Haleva.

6 USHER: Haleva.

7 JUDGE MARTIN: I'm sorry, Haleva?

8 MR. HALEVA: Yes, yes.

9 JUDGE MARTIN: Good morning.

10 MR. HALEVA: Yes, good morning.

11 JUDGE MARTIN: Oh, do you have a business card for the
12 reporter?

13 MR. HALEVA: I certainly do.

14 JUDGE MARTIN: Oh, for the reporter.

15 MR. HALEVA: Oh, understood.

16 JUDGE MARTIN: Okay. You can proceed whenever you're
17 ready.

18 MR. HALEVA: Okay. Good morning, Your Honors. I am
19 Aaron Haleva, and I'm here representing XM Satellite Radio and the
20 inventors Neil Eastman, Michael Zingman and Michelle Sammartino (ph),
21 regarding United States Patent Application No. 10626244. This is a novel
22 system which couples essentially a satellite radio with a computer.

23 Although some of the prior art, which I'll discuss in a few
24 minutes, suggests that you could integrate a computer with a satellite radio
25 receiver, none of them go into the great detail about using the display
26 capabilities of a satellite radio receiver -- I mean of a computer, sorry, to

1 display all or some of the plethora of information that comes through the
2 broadcast stream via a satellite radio receiver.

3 JUDGE MARTIN: Now the claims don't require that there be a
4 display of much data, right? You could have just information about two
5 channels, a couple of channel numbers, for example? You don't need, you
6 know, a complete list of the channels.

7 MR. HALEVA: You don't need a complete list, no.

8 JUDGE MARTIN: And plurality's pretty small, so it could be a
9 display of a couple of channels. Okay.

10 MR. HALEVA: But they do provide that for however many of
11 those channels you select, and you're correct. However many of them you
12 do select, that they have a plurality of artist's names, song titles, channel
13 names, etcetera, etcetera, and that it's simultaneously updated.

14 JUDGE MARTIN: I'm sorry, but the claim says at least a
15 portion of the data, and then it lists those types of data you mentioned, the
16 channel numbers, artist names, song titles.

17 MR. HALEVA: Yes, correct.

18 JUDGE MARTIN: I mean a portion. That could be
19 information about -- I mean that doesn't have to be much to be a portion.

20 MR. HALEVA: It could be a few channels and a few or one, a
21 portion of that string of available information for that channel.

22 JUDGE MARTIN: So it would seem like two channel numbers
23 would be enough?

24 MR. HALEVA: I think plurality would be maybe -- I would
25 grant three.

1 JUDGE MARTIN: All right. Say, plurality is three. But still
2 the portion part means that the channel numbers by themselves would be
3 enough without any other information.

4 MR. HALEVA: That's correct.

5 JUDGE MARTIN: Okay. I was going to make sure really how
6 broad this claim is.

7 MR. HALEVA: You're right. However, the claim does set
8 forth that you could choose from in your selection, from any of these
9 channels, and you could choose any of this information.

10 Now we don't think that the prior art teaches that, and if you
11 look for an example of what we're trying to claim here, and I grant it's a bit
12 broad, Figures 5 through 6 or 5 through 7 even of the present application
13 show an example of selection of a number of channels, and a number of
14 those data types such as channel, artist title, category, etcetera.

15 We don't believe that that's taught by the prior art, and here's
16 why. Each and every rejection that we're appealing from contains a
17 combination of three references, sometimes two. Hilt, Marco and
18 Rindsberg.

19 Hilt and all three are patents of XM Satellite Radio, the
20 assignee herein. As I'll get to in a moment, and as I detailed in my Reply
21 Brief, we don't believe the Marco reference is valid under 35 U.S.C. 103(c),
22 because it is under common assignment with the present application.

23 JUDGE MARTIN: Well, the Manual [of Patent Examining
24 Procedure] goes into a lot of detail about this, and it said that the kind of
25 evidence you need to establish a 103(c) exception is really no more than just

1 a statement that the reference was commonly owned with the present
2 application at the time of the invention.

3 MR. HALEVA: That's right, yes.

4 JUDGE MARTIN: I don't see in the Reply Brief any mention
5 of "at the time of the invention." I see the dates.

6 MR. HALEVA: We're accepting as the only definable date as
7 to the invention the filing date.

8 JUDGE MARTIN: Well, you didn't say anywhere that that's
9 the time that it mentioned. I mean we do have Rule 131 practice that lets
10 people take their dates back. All right. Anyway, that's a problem.

11 MR. HALEVA: I would also say this, though. Whenever it
12 was written, if you'll look in the Marco reference, there is a line which
13 identically appears in the present application, and that in the Marco reference
14 it is paragraph six of the published application in the background sections,
15 describing the satellite radio system in the United States.

16 It says, 12.5 -- this is on the bottom of page one, paragraph six.
17 "12.5 megahertz of which are owned by the assignee of the present
18 application, XM Satellite Radio, Inc." That's the Marco. That's the prior art
19 we object to. If you look at the present application, you find the exact same
20 statement.

21 In fact, you find the exact same paragraph at paragraph three of
22 the published version of the present application, and the same final words
23 which say "12.5 megahertz of which are owned by Sirius Satellite Radio,
24 and 12.5 megahertz of which are owned by the assignee of the present
25 application, XM Satellite Radio.

1 I think the fact that the -- and I cited, I did provide in the Reply
2 Brief the real and frame as to the assignment of the present, of the Marco
3 application to XM Satellite Radio, and there is a parallel assignment for the
4 present application.

5 Which I think leads one to a very likely conclusion that, under
6 35 U.S.C. 103(c), they were either under an obligation to assign, and we see
7 that by the fact that they did in fact assign, or they were, at the time of the
8 invention, owned by XM Satellite Radio. That's the basis for our objection.

9 JUDGE MARTIN: Now there is another problem besides the
10 absence of the "at the time the invention was made" language, and that is
11 that this didn't come up until the Reply Brief.

12 MR. HALEVA: I agree. Now, and you probably are
13 wondering about that. I inherited this case. All I did in this case was write
14 the Reply Brief. I looked at the record, and I wish I had been involved
15 earlier, and I would have called the Examiner as soon as the final Office
16 Action, which was in 2007 that we're all here about today, would have
17 issued.

18 I would have said Examiner, you know, I think this is invalid
19 art because it's one of ours. I understand you did a good search and the best
20 art you found is all our own art. But this particular one, because it didn't
21 publish until after we filed for some time, is 102(e) art, as he points out in
22 the rejections, and because of that, it's an invalid rejection.

23 Now I understand I'm only raising this in the Reply Brief. I
24 think it's a jurisdictional issue essentially. I don't think you can waive your
25 rights under 35 U.S.C. 103, and certainly the client's interests are not

1 protected just because their prior patent prosecution counsel didn't notice
2 what 103(c) art is.

3 I would ask Your Honors to consider that it's a matter of form
4 over substance. In the alternative, instead of granting the appeal, I suppose
5 you could remand based on Your Honor's notice that 103(c) has been
6 violated, or likely has been violated, and that a better rejection should be
7 formulated. I don't think there is a better rejection that can be made.

8 I also want to say that even if you combine all three references,
9 you don't get the claimed display, albeit with a, you know, narrowing, as you
10 pointed out very aptly. The claim doesn't require a lot of channels and it
11 doesn't require a lot of this information. But it puts a pallet of channels and
12 a pallet of information in the user selects.

13 None of the art, even if you combined all of them, teaches that,
14 because the Examiner relies on Marco for decoding and extracting all this
15 information we've talked about, the channel numbers, artist names, song
16 titles, etcetera, etcetera, etcetera.

17 JUDGE HAHN: Counsel?

18 MR. HALEVA: Yes.

19 JUDGE HAHN: In the substance side of this, did you
20 personally yourself do a chain of title search on this Marco reference?

21 MR. HALEVA: Yes.

22 JUDGE HAHN: And you can therefore, to the best of your
23 information and knowledge, Marco was owned at the time of invention for
24 this application?

1 MR. HALEVA: It was under a duty to assign. Let's assume
2 that the invention was some time prior to handing an invention disclosure to
3 the patent counsel.

4 JUDGE HAHN: But it was under a duty?

5 MR. HALEVA: It was under definitely a duty. Yeah, Marco
6 is -- you may have heard that Sirius Satellite Radio merged with XM
7 Satellite Radio. Marco stayed with the joint company for a short time, is no
8 longer with XM Satellite Radio, more or less because a lot of what he was
9 doing was redundant, and he wanted to move on.

10 So that's why he's no longer with the company, but he was one
11 of the key inventors of the XM Satellite Radio patent portfolio. He was
12 under a, as all of them area, and I happen to know that because we get
13 involved with those contracts as well, as all of their inventors are, as all the
14 inventors of Sirius Satellite Radio are, and they routinely execute
15 assignments as soon as they're asked.

16 Everything he was doing here was on company time, and the
17 people he was working with in the Marco application were also inventors of
18 XM Satellite Radio. Craig Wadin (ph) is still with the company. In fact,
19 he's very high up in the technology side of the company. So yes, absolutely.

20 JUDGE MARTIN: Thank you. Can we hear your comments
21 about what Marco is talking about doing there in paragraph 28, that that
22 information that is text that's coming in is not going to be converted to
23 speech, and it includes -- it can be optionally displayed and it's got the
24 programming information.

25 MR. HALEVA: Yes.

26 JUDGE MARTIN: What is being displayed there?

1 MR. HALEVA: Okay. So let me back up one step, and in case
2 you're not thoroughly familiar with satellite radio and how it works. You
3 may have been aware that one of the holy grails of radio, and that's why they
4 go to digital radio now, is to not only send the sound signal through a
5 speaker, but to send some information about the song being played.

6 In fact, in newer model automobiles, even on FM radio, you get
7 a little bit of that, but a very, very little bit of it, maybe 20 characters and
8 you see this little buffer and so on. If you digitize the audio, it's very easy to
9 digitize characters, which have a much smaller bandwidth than the audio,
10 and format them or frame them in the same packet. Or, you could frame all
11 the descriptive text. The Sirius system calls it "program descriptive text."

12 The XM system always called it "service descriptive text." It's
13 the same thing. It's the name of the artist, the album, which type of -- what
14 genre it is, things like that, the song title, etcetera.

15 Because you have all digital data, now you have the stream at
16 the receiver, which you can extract the program descriptive text from the
17 audio, send the audio to a speaker, and send the program descriptive text
18 somewhere.

19 In this Marco application, it's converting it to speech, because
20 as you know, many satellite radios are directed to people in automobiles. If
21 we gave you a whole DirecTV type electronic program guide on your little
22 console, even if you could see it, you might get into accidents.

23 So the idea behind this Marco application was to why don't we
24 convert it to text, like you have on some of the navigation systems now, as
25 you're entering an address to speak the letter you're using to spell out a
26 name, and that's what the text to speech was about.

1 The only mention, I think, in all this prior art, of displaying the
2 information referred to in the independent claims of the present application,
3 is right there. It is where it says "you may opt" -- in paragraph, I think it's
4 28, "and you may optionally display some of that text."

5 It doesn't say any more than that. I think someone with skill in
6 the art would understand that some subset of that text that's sitting in the text
7 buffer, which is illustrated in, let's see, I think Figure 6, Item 406. There's a
8 text buffer. That's where that PDT I was just describing a moment ago is
9 extracted and it's sent to, once it's extracted.

10 Then the Marco application is about sending it further on to the
11 audio encoder and I'm sorry. Figure 6 is the transmitter. Figure 7, Figure 7.
12 There's a text decompression. The text goes into there, and then from there
13 it can go to text to speech.

14 They say in the end of that paragraph 28 that optionally in
15 display 617 of Figure 7, you could display some of that text. That would be
16 a subset of this stream of a number of channels, each having all this
17 descriptive information possibly.

18 JUDGE MARTIN: Now would that be just for the channel
19 that's being received?

20 MR. HALEVA: I think so, yes.

21 JUDGE MARTIN: It says "for a given channel," but it doesn't
22 say it's the one.

23 MR. HALEVA: But, you know, I'm not sure. I mean I think it
24 could admit of, although the application doesn't really support this in any
25 detail. It could admit of taking some of that text from another channel. I
26 think the intent of the paragraph is yes, the one you're listening to.

1 So as you listen to, you know, blue grass, you hear information
2 about the artist. Then as the song changes, you hear the new information,
3 and optionally, you could display some of it. But the information's all there.
4 I think this is the closest that any of the cited prior art gets to displaying this
5 type of information.

6 Rindsberg is only talking about storing this information in a
7 channel. Let me see what it's called exactly. In Figure 6, there's a channel
8 status table, a channel reference table. It's referred to at the bottom of
9 Column 4 of the Rindsberg reference. The Examiner construes this as
10 somehow being displayed, and I think as was written in the appeal brief,
11 that's just plain wrong.

12 If you read the Rindsberg reference carefully, what's shown in
13 Figure 6 is never displayed anywhere. It's stored in Figure 5, memory
14 element 504, which is the channel reference table block. Yes, the
15 information is extracted from the signal, but it's put in this channel reference
16 table and it's not displayed.

17 There's an easy reason why. There's no computer in Rindsberg.
18 So you cannot exploit the display capabilities of a computer screen or the
19 user's ability to modify how the information on the computer screen is
20 displayed, as is described in great length in the present application, with all
21 the discussion of the user interface or the UI in paragraph 38, 39, 40 and
22 they show in the Figures 5 through 8 how a user can go ahead and
23 manipulate.

24 There's one version, then there's another version. All this is
25 possible, the display or the claimed display of all these elements is only
26 possible because of the computer. So if you take, and I think all Hilt, the

1 cited art reference Hilt, all Hilt supplies you is the notion that there's a
2 computer connected to an XM Satellite Radio receiver.

3 JUDGE MARTIN: Let's go back to Rindsberg for a minute.

4 MR. HALEVA: Yes.

5 JUDGE MARTIN: I've got a question about a passage in
6 Column 5, and we've got it handy, starting line 20. This is about the alerting
7 of the user of other channels that may have --

8 MR. HALEVA: Yes, yes.

9 JUDGE MARTIN: Data or information of interest. Well, it
10 says that the -- at Step 710, "A user is alerted of a channel or channels,"
11 plural, "containing an indication of the content of the desired type."

12 MR. HALEVA: Yes.

13 JUDGE MARTIN: So there's a display of apparently at least
14 two channels. I mean it can be two.

15 MR. HALEVA: I don't know if there's a display but rather an
16 alert.

17 JUDGE MARTIN: Well then -- well, look at the rest of this. It
18 says it can be channel number or numbers can be displayed.

19 MR. HALEVA: That's right.

20 JUDGE MARTIN: Okay.

21 MR. HALEVA: So I agree, that when an alert happens, and
22 this is kind of an old idea and it's been around the satellite radio industry for
23 a while, you have a favorites list or a preferences list, and the receiver
24 automatically, based on this stream of data, which is the PDT, the program
25 descriptive text, this long data stream which is encoded with the audio but

1 extracted at the receiver, it's now stored, and the receiver can search through
2 that at any time to match any of the user preferences.

3 When a preference, let's say I like Sinatra. So if it finds a
4 Sinatra song playing on any of the channels in the broadcast stream of up to
5 120, and it tells you Sinatra playing on Channel 58. That's not the plurality
6 or the portion of the data associated with the plurality of channels that we're
7 talking about here.

8 JUDGE MARTIN: What if Sinatra's on two channels?

9 MR. HALEVA: I think it will give you successively. It will
10 give you a beep that says "Sinatra on 58"; then it will give you another beep
11 that says "Sinatra on 62." But it's never displaying to you that kind of a grid
12 with all this information, and it's not simultaneously updating it.

13 There's no reference in Rindsberg to simultaneously updating
14 an alert. Once you get an alert, you get an alert.

15 JUDGE MARTIN: Okay. It goes on to say that "the display or
16 alert can prompt, can serve as a prompt for the user to enter an input to select
17 such channels containing desired content." In one way, the user is going to
18 have a choice.

19 MR. HALEVA: Is to press a button that says "Sinatra on 58"
20 and if you press a button you'd jump there. There's a little jump button on a
21 lot of these receivers.

22 JUDGE MARTIN: So you're saying what we're missing is
23 having these two channels be displayed simultaneously?

24 MR. HALEVA: That's right, and continuously updated, and the
25 two channels are more than two channels, the plurality, whatever the
26 plurality is, with some portion of all that available data.

1 JUDGE MARTIN: Which actually can be just the channel
2 number or the Sinatra name. I mean it could have two things in your
3 example.

4 MR. HALEVA: You could, yes. So I'm saying the difference
5 between Rindsberg and the claims, the independent claims, is in fact that an
6 alert happens once. The alert is not -- that particular channel to which the
7 alert points is not continually and simultaneously updated.

8 JUDGE MARTIN: This is a 103 rejection, right? We don't
9 have to find an express teaching of displaying both, if it would have been
10 obvious to display both. It makes it easier for the user to see what the
11 options are.

12 MR. HALEVA: That's right, but if you look at the Rindsberg
13 little display, is that a -- what would you combine it with? There's a
14 computer coupled with the display that we claim that allows you to do all of
15 this functionality. I don't see that Rindsberg talks about displaying a
16 plurality of channels, even if it's there, and I don't see it talks about
17 displaying or leads one skilled in the art to understand that you could do a
18 plurality of channels, continually displayed with one of those, even the
19 channel name, which would be trivial.

20 I mean you can't display just the channel name. You have to
21 display the channel name and something about it, and what good is the
22 whole invention?

23 JUDGE WHITEHEAD: Right. But doesn't it do it -- I'm sorry,
24 I interrupted you. But it doesn't do it just at one time as you scroll through,
25 right, because I have Frank Sinatra at so and so channel. It can go right

1 through a listing. So if you had like -- and you say the display in Rindsberg,
2 that's not really made to size. We don't know what size that is, right?

3 MR. HALEVA: But then once -- you're right. But once you
4 scroll through, like the Fox News reader board, you don't have a plurality of
5 channels being simultaneously updated and displayed on the graphical user
6 interface. That little display, I don't even know if it is a graphical user
7 interface. It's just a display, because it doesn't have any of the properties of
8 graphical user interface that are described in the present application, which
9 allow a user to play with the formulating --

10 JUDGE HAHN: Well, it says the user can pick the channel, the
11 alert channel they want to go to. That's certainly graphical user interface,
12 isn't it?

13 MR. HALEVA: Is it -- it's not changing the display properties.
14 It's just changing the content on which the display -- which is displayed on
15 the display, but it doesn't allow you to interact with the interface as is
16 described in our application.

17 JUDGE MARTIN: All right. Any questions?

18 JUDGE HAHN: No questions.

19 JUDGE MARTIN: No further questions. Thank you very
20 much.

21 MR. HALEVA: Thank Your Honors.

22 Whereupon, at 10:55 a.m., the proceedings were concluded.
23